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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,747	07/09/2003	Chih-Yeh Chao	P-3641.243	9886
7590 07/15/2004			EXAMINER	
Jackson Walker L.L.P. Suite 2100 112 E. Pecan Street San Antonio, TX 78205			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,747

Applicant(s)

CHAO ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's election without traverse of Group I, claim 1-5 in the reply filed on June 22, 2004 is acknowledged.

Claim 6-11 have been withdrawn from consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Bissonnette et al. (USPN 6605007).

Regarding claim 1, Bissonnette et al. disclose a golf club head comprising a body having a shank, a hosel 24 and a face 16, the shank formed on the body and the hosel defined at the shank of the body and adapted to connect to a shaft of a golf club; the face formed on the body and adapted to hit a golf ball; and a faceplate 16 with a sweet spot and a softened region, the softened region formed around the sweet spot in the faceplate; wherein the softened region is softer than the sweet spot (See Abstract and Figures 1 and 2).

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2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hardman (USPN 5405136).

Regarding claim 1, Bissonette et al. disclose a golf club head comprising a body 85 having a shank, a hosel and a face 86, the shank formed on the body and the hosel defined at the shank of the body and adapted to connect to a shaft of a golf club; the face formed on the body and adapted to hit a golf ball; and a faceplate 79 with a sweet spot 80 and a softened region 81-84, the softened region formed around the sweet spot in the faceplate; wherein the softened region is softer than the sweet spot (See Column4, lines 19 through 35, and Figures 11 and 12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bissonette et al. (USPN 6605007).

Regarding claim 2, Bissonette does not explicitly disclose the hardness difference of the soften region and sweet spot. Bissonette et al. is only concern with the sweet spot being harder than the soften region, furthermore, applicant does not disclose why it is essential for the hardness difference to be 20 to 22H_{RC} in order to attain the invention. One having ordinary skill in the art would have found it obvious to have the

hardness difference of the soften region and the sweet spot to be any value so long as it increases the coefficient of restitution of the club head.

Regarding claim 4, Bissonette et al. discloses the faceplate is made out of titanium alloy (See Column 12, lines 60 through 65).

Regarding claim 5, Bissonette et al. discloses the faceplate is made out of stainless steel (See Column 12, lines 60 through 65).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bissonete et al. (USPN 6605007) in view of Schumacher (USPN 5089067).

Regarding claim 3, Bissonette et al. does not disclose the type of stainless steel used. Schumacher discloses a maraging stainless steel, or martensitic steel having 4% copper, for use in golf clubs (See Summary of the Invention). One having ordinary skill in the art would have found it obvious to use maraging steel as taught by Schumacher, in order to improve the feel of the club head.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

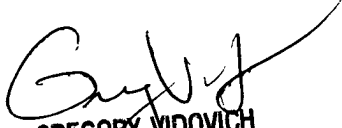
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached at 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
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